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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,018	12/29/2003	Michael H. Wong	MERLYN-1/CIP-3	8426

1054 7590 09/08/2005

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EXAMINER

MITCHELL, TEENA KAY

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TW

Office Action Summary	Application No.		Applicant(s)	
	10/749,018		WONG ET AL.	
	Examiner		Art Unit	
	Teena Mitchell		3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/29/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

While applicant in the first paragraph of the specification has listed the instant application is a Continuation in Part of application 10/117,571 applicant is required to list the current status of the '571 application, which is US Patent 6,761,171, correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (4,150,676) in view of Linder et.al. (3,957,055).

With respect to claim 1, Jackson discloses an endotracheal tube having an articulate tip (2); while Jackson does not disclose a stylet Linder teaches a stylet (10) comprising an elongated immalleable rod having a diameter that is less than the inner diameter of said tube and having a length that is shorter than said tube (Figs. 1, 2, 4) providing stylet for use with endotracheal tubes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tube of Jackson to employ any well-known stylet as the use of stylets in the placement of endotracheal tubes is well known in the art.

With respect to claim 2, Linder teaches wherein the rod is shaped to conform to the curvature of said tube (Figs. 1, 2, 4).

With respect to claim 3, Linder teaches a limiting device (12) affixed to the proximal end of said rod (Figs. 1, 2, 4) of said rod for engaging the proximal end of said tube to limit the insertion of said rod into said tube (Figs. 1, 2, 4).

With respect to claim 4, Linder teaches wherein said limiting device is shaped for grasping by at least one finger of a human hand (via loop).

With respect to claim 5, Linder does not teach the rod having a distal end having an enlargement. At the time the invention was made, it would have been an obvious matter of design consideration to a person of ordinary skill in the art to have the rods distal end have an enlargement because Applicant has not disclosed that having an enlargement at the distal end of the rod provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the distal end of the rod being the same size as the proximal end. Therefore, it would have been an obvious matter of design consideration to modify Linder to obtain the invention as specified in claim 5.

With respect to claims 6 and 7, note rejection of claim 5 above.

With respect to claim 8, Linder does not teach the rod diameter which is in the range of 2 mm to 11 mm. However, Linder does teach that the guide may be made in a range of thicknesses and lengths appropriate for cooperation with all endotracheal catheters (Col. 1, lines 31-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the rod diameter in the range of 2mm to 11 mm based on the endotracheal catheter being used as taught by Linder.

With respect to claim 10, Linder does not teach the rod made of biocompatible polymer. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the rod of a biocompatible polymer, since it has been held to be within the general skill of a worker in the art to select a known material on the

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basis of its suitability for the intended use as a matter of design consideration. In re Leshin, 227 F.2d 197, 125 USPQ 416.

With respect to claim 11, Jackson discloses an endotracheal tube having an articulable distal portion (Figs. 1 and 2). Linder teaches a stylet for insertion into the tube to rigidize the tube along the tube length not including the articulable distal portion, the stylet comprising: an elongate, shape-retaining, semi-rigid rod (10) having a diameter smaller than the inner diameter of said tube and having a length that is shorter than said tube (Figs. 1, 2, 4).

With respect to claim 12, Linder teaches wherein the rod is shaped to conform to the curvature of said tube (Figs. 1, 2, 4).

With respect to claim 13, Linder teaches a limiting device (12) affixed to the proximal end of said rod (Figs. 1, 2, 4) of said rod for engaging the proximal end of said tube to limit the insertion of said rod into said tube (Figs. 1, 2, 4).

With respect to claim 14, Linder teaches wherein said limiting device is shaped for grasping by at least one finger of a human hand (via loop).

With respect to claims 15-18, note rejection of claim 5 above.

With respect to claim 19, note rejection of claim 9 above.

With respect to claim 20, note rejection of claim 10 above.

With respect to claim 21, note rejection of claim 9 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show stylets and endotracheal

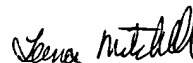
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tubes: 6,722,367; 6,422,239; 5,791,338; 5,257,636; 5,058,577; 5,024,220; 3,460,541;
4,637,388; 4,593,687; 4,589,410.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teena Mitchell whose telephone number is (571) 272-4798. The examiner can normally be reached on Monday-Friday however the examiner is on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Teena Mitchell
Primary Examiner
Art Unit 3743
September 2, 2005

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